

JUL 14 2008

PATENT

Attorney Docket Nos. VM7010755001

(Formerly 267/032)

Varian No. 98-33-01 US

REMARKS

Amendments to claims 30 and 53 are for the purpose of clarifying what Applicant regards as the invention. Amendments to claims 58, 59, 61, and 64 are to change claim dependency. No new matter has been added.

**I. Claim Election**

Claims 57-64 have been withdrawn from consideration as allegedly directed to a non-elected invention. Claim 57 has been canceled, and claims 58-64 have been amended to depend from new independent claim 65, which recites the same limitation "reflective elements" as that in claim 53.

**II. Claim rejection under § 112**

Claims 29-32, 34, 35, 38-45, 49, and 52-56 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. According to the Office Action, claims 30 and 53 allegedly omit the essential element "an optical imaging apparatus." In particular, according to page 5 of the Office Action, the element "an optical imaging apparatus" is allegedly essential because Applicant elected the marker system. However, Applicant respectfully notes that the test of essential element is not whether the element is considered by the Examiner to be a component of a system elected by Applicant, but rather, whether Applicant explicitly describes such element to be essential in the specification (See MPEP § 2172.01 - which states that a rejection under § 112 is proper when "a claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record."). In this case, the subject specification does not describe such element to be essential. Also, as described in pages 16-17 and figures 7, 9, and 10 of the specification, an embodiment may include just the marker (without the optical apparatus). For at least the foregoing reasons, Applicants respectfully request that the § 112 rejection for claims 30 and 53, and their respective dependent claims, be withdrawn.

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III. Claim rejection under § 103

Claims 29-31, 34, 35, 38-45, 49, and 52-54 stand rejected under 35 U.S.C. § 103 as being unpatentable over Josefsson in view of U.S. Patent No. 6,061,644 (Leis).

Claim 30 has been amended to recite a marker block having two reference locations that are spaced apart from each other. Claim 53 has been amended to recite a marker block having two reflective elements that are spaced apart from each other. Neither Josefsson nor Leis discloses or suggests such marker blocks. Josefsson discloses attaching individual retro-reflective materials directly to a patient's body (see page 121, bottom of right column, and figures C and E on page 127), and therefore, does not disclose or suggest a marker block having two reference locations or two reflective elements that are spaced apart from each other. Also, because in Josefsson, the retro-reflective materials are structurally independent from each other, Josefsson in fact teaches away from a common structure (i.e., a marker block) that is used to carry two or more reflective elements.

According to the Office Action, Josefsson discloses a half-spherical marker (which the Examiner considered to be a marker block), and reflective paint (which the Examiner considered to be reference locations on a marker block). Claim 30 has been amended to clarify that the reference locations are spaced apart from each other, and claim 53 has been amended to clarify that the reflective elements are spaced apart from each other. Josefsson does not disclose or suggest a marker block having two reference locations or two reflective markers that are spaced apart from each other.

Leis also does not disclose or suggest the respective marker blocks of claims 30 and 53, and therefore fails to make up the deficiency present in Josefsson. Rather, Leis discloses surgical instruments 11a, 11b, each of which includes a plurality of markers 12 (column 3, lines 58-60). Nothing in Leis teaches or suggests use of a marker block, nor does Leis suggest the desirability of departing from the system therein and using a marker block instead. Since neither Josefsson nor Leis discloses or suggests the marker blocks as recited in claims 30 and 53, they

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cannot be combined to form the resulting subject matter of these claims. For at least the foregoing reason, claims 30 and 53, and their respective dependent claims, are believed allowable over Josefsson, Leis, and their combination.

In addition to the foregoing, nothing in either reference contains any teaching or suggestion that they be combined or the desirability of such combination.

**IV. Claims 58-65**

New claim 65 recites coupling a first reflective element to a first portion of a person, and coupling a second reflective element to a second portion of the person, wherein the first reflective element remains substantially stationary relative to the second reflective element during the procedure. Applicant respectfully submits that claim 65 and its dependent claims are allowable over Josefsson and Leis since neither reference discloses or suggests the above limitations. In particular, Leis discloses securing markers to a surgical instrument, and therefore, does not disclose or suggest coupling reflective elements to a person. In addition, Josefsson discloses placing markers on different body parts that move relative to each other during a procedure (i.e., so that an animation can be created). As such, Josefsson in fact teaches away from reflective elements that remain substantially stationary relative to each other during a procedure.

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CONCLUSION

If the Examiner has any questions or comments regarding this response, please contact the undersigned at the number listed below. Further to the Power of Attorney filed on March 6, 2003, please change the attorney docket number from [267/032] to reflect Bingham McCutchen's docket number, which is: VM7010755001.

The Commissioner is authorized to charge any fees due in connection with the filing of this document to Bingham McCutchen's Deposit Account No. 50-2518, referencing billing number 7010755001. The Commissioner is authorized to credit any overpayment or to charge any underpayment to Bingham McCutchen's Deposit Account No. 50-2518, referencing billing number 7010755001.

DATE: July 14, 2006

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